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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,377	08/22/2003	Walter Hehl	CH920010016US1	9975

7590 09/21/2006

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EXAMINER

NELSON, FREDA ANN

ART UNIT PAPER NUMBER

3639

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/646,377

Applicant(s)

HEHL ET AL.

Examiner

Freda A. Nelson

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 13-15, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 6-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This is in response to a letter for a patent filed August 22, 2003 in which claims 1–19 were presented for examination. Claims 1-19 are pending.

#### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Drawings***

2. The drawings are objected to because in FIG. 2, in descriptive text boxes for reference(s) **34** and **42**, “**POSITIONNING**” should be “**POSITIONING**”. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

Art Unit: 3639

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities:

Page 1, line 22, "overload" should be "overloaded";

Page 2, line 2, "to receive" should be "from receiving";

Page 2, line 30, "there" should be "There";

Page 3, line 3, "trough" should be "through";

Page 3, line 6, insert "a" before "few"; and

Page 4, line 1, "allow" should be "are allowed"

Appropriate correction is required.

### ***Claim Objections***

4. Claim 7 is objected to because of the following informalities:

In claim 7, line 5, "lever" should be "level".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-5, 7, 9, 11-12, and 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the client device" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "this one" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the client device" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the client device" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the decision" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the guidelines" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the guidelines" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 12 and 16-17, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-4, 13-15, and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Jensen (US PG Pub. 2002/0107697).**

As per claims 1 and 18-19, Jensen discloses a method for dynamically allocating a cost to an e-mail that a first user of a transmission network who is of a member of a group, wants to forward to a second user of the transmission network who is also a member of said group, comprising the steps of:

forwarding by said first user said e-mail to a market engine in charge of allocating a cost to said e-mail (paragraph [0052]);

determining by said market engine the cost of said e-mail based upon intrinsic and extrinsic criteria (paragraph [0053],[0177]);

submitting the cost of said e-mail to said first user for agreement (paragraph [0054]);

forwarding by said market engine said e-mail to said second user (paragraph [0054]); and

updating a credit account associated with said first user (paragraph [0048],0062],[0183]).

As per claim 2, Jensen discloses the method according to claim 1, further comprising the step of running said market engine as a local market engine when running at the client device associated with each user (paragraph [0120],[0124],[0128]).

As per claim 3, Jensen discloses the method according to claim 1, further comprising the step of running said market engine as a central market engine including a user credit database which contains the credit accounts of all users and which is accessed by said central market engine when this one has to determine the cost of said e-mail (paragraph [0048])

As per claim 4, Jensen discloses the method according to claim 3, further comprising the step of maintaining the credit account of each user in a credit database at the client device associated with said user (paragraph 0048)).

As per claim 13, Jensen discloses the method according to claim 1, further comprising the step of re-prioritizing and repositioning said e-mail by said second user when it is received from said market engine (paragraph [0206]).

As per claim 14, Jensen discloses the method according to claim 1, further comprising the step of providing said group as a large company and said users as employees of said company (paragraph [0210]).

As per claim 15, Jensen discloses the method according to claim 1, further comprising the step of providing said market engine as a central market engine when running as a server (FIG. 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen (US PG Pub. 2002/0107697) in view of Tanigawa (US PG Pub. 2003/0074255).**

As per claim 5, Jensen does not expressly disclose the method according to claim 4 wherein said step of maintaining said credit account included in the credit database of said central market engine and the credit database at the client device associated with each user further includes the step of providing for said user a number of credit points at some specific periods.



However, Tanigawa discloses that a point is added to a user member in accordance with the contents of the action of the member such as reception of an electronic mail from the mail delivery terminal 6 or transmission of a reply to a received electronic mail, and point information for each member is stored in the member registered information database 4 (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Jensen to include the feature of Tanigawa in order to increase users by awarding points to be passed on as money (Tanigawa, [0011]).

### ***Conclusion***

6. The following is an examiner's statement of reasons for allowance:

A) the prior art for example:

(1) Jensen (US PG Pub. 2002/0107697), discloses a method and system to enable, to organize, to facilitate, and to transact communications for a fee or cost utilizing a network such as the Internet.

(2) Tanigawa (US PG Pub. 2003/0074255), which discloses a method of transmitting and receiving information using electronic mail.

However, in regard to claims 6-11 the prior art does not teach or suggest specific manner in which the e-mail is dynamically priced as recited in these claims.

7. The examiner has cited prior art of interest, for example:

1) Bodensohn (US PG Pub. (2003/0105712), which discloses a messaging system and method.

2) Brechner et al. (US PG Pub. 2003/0144903), which disclose systems and methods for disseminating information.

3) Pena (US Patent Number 6,292,211), which discloses a computer-aided telecommunication system and method.

4) Schiavone et al. (US PG Pub. 2002/0120600), which disclose a system and method for rule-based processing of electronic mail messages.

5) Zellner et al. (US PG Pub. 2006/0023665), which disclose a method for dynamic multi-level pricing for wireless communications according to quality of service.

6) "GotMarketing Sold on MetraTech; MetraTech Powers Dynamic pricing and Billing For GotMarketing's E-mail Marketing Tools", Jul 9, 2001, Business Wire. New York, pg. 1.

7) "INSTIL: Instil propels dynamic pricing, exchange and procurement technology to a new level", M2 Presswire, pg. 1.

8. Claims 6-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 C.F.R. § 1.111(b) and section 707.07(a) of the M.P.E.P.

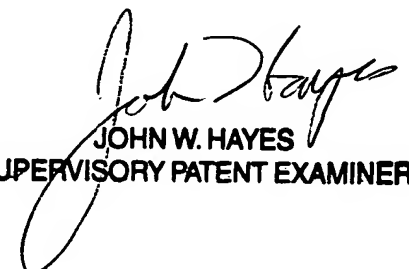
9. The shortened statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FAN 09/14/2006



**JOHN W. HAYES**  
**SUPERVISORY PATENT EXAMINER**